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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Orna Mor, et al.

Serial No.: 10/579,662 Examiner: Janet L. Epps-Ford

Filed : May 17, 2006 Art Unit: 1633

For : DIAGNOSIS AND TREATMENT OF KIDNEY FIBROSIS AND OTHER FIBROTIC DISEASES

1185 Avenue of the Americas
New York, New York 10036
August 25, 2008

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO JUNE 23, 2008 OFFICE ACTION AND PETITION FOR A ONE-MONTH EXTENSION OF TIME

This Communication is submitted in response to the June 23, 2008 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the June 23, 2008 Office Action was due July 23, 2008. Applicants hereby petition for a one-month extension of time. The fee for a one-month extension of time for a small entity is SIXTY DOLLARS ($60.00) and a check for this amount is enclosed. With a one-month extension of time, a response to the June 23, 2008 Office Action is now due August 23, 2008. However, under 37 C.F.R. §1.7(a), when the last day for taking any action in the United States Patent and Trademark Office falls on a Saturday, Sunday, or Federal holiday, the action may be taken on the next succeeding business day. Since August 23, 2008 was a Saturday, a response filed on the next succeeding business day, i.e. Monday, August 25, 2008, is to be considered timely. Therefore, a response to the June 23, 2008 Office Action is being timely filed.

Restriction Requirement:

In the June 23, 2008 Office Action, the Examiner required restriction under 35 U.S.C. §121 of pending claims 1-2, 4-9, 19, and 21-27 to one of following allegedly patentably distinct inventions.

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I. Claim 4, drawn to a method of treating a fibrosis related pathology comprising the administration of an antisense inhibitor of phospholipase D3;

II. Claims 5-6, drawn to a method of treating a fibrosis related pathology comprising the administration of a siRNA inhibitor of phospholipase D3;

III. Claim 7, drawn to a method of treating a fibrosis related pathology comprising the administration of an antibody inhibitor of phospholipase D3;

IV. Claims 21-22, drawn to pharmaceutical composition comprising an antisense oligonucleotide inhibitor of phospholipase D3;

V. Claims 21 and 23-24, drawn to pharmaceutical composition comprising a siRNA oligonucleotide inhibitor of phospholipase D3; and

VI. Claim 25, drawn to pharmaceutical composition comprising an antibody inhibitor of phospholipase D3.

Further, in the June 23, 2008 Office Action the Examiner indicated that claims 1-2 and 7-9 link invention groups I-III and claims 19, 26 and 27 link invention groups IV-VI and that upon allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise requiring all the limitations of the allowable linking claims will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104.

In response to the restriction requirement, applicants hereby elect, with traverse, to prosecute the invention identified by the Examiner as Group II, claims 5-6, drawn to method of treating a fibrosis related pathology comprising the administration of a siRNA inhibitor of phospholipase D3.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement particularly as it relates to Group I (claim 4). Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Nevertheless, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of the other groups, particularly Group I would not impose a serious burden since as noted in the Office Action on page 2, both Group I and Group II are classified in class 514, subclass 44. Applicants further maintain that the claims of Group I and II should be examined together because the administration of a siRNA inhibitor of phospholipase D3, i.e. claims 5-6, involves an inhibitor which includes an antisense strand. Accordingly, applicants maintain that there is not an undue burden on the Examiner. Therefore, applicants request that the Examiner examine all groups and at least Groups I and II in the subject application.

In view of the foregoing, applicants maintain that restriction under 35 U.S.C. §121 was not proper at least as between Groups I and II, and respectfully request that the Examiner reconsider and at least withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee other than the enclosed $60.00 fee for the one-month extension of time is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
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John P. White 8/25/08

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